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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR       | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/074,727      | 02/12/2002  | Stephan Erich Hills Strebl | STREBL- MOBILE      | 6716             |

7590 01/15/2003

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EXAMINER

SUHOL, DMITRY

ART UNIT PAPER NUMBER

3712

DATE MAILED: 01/15/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/074,727

Applicant(s)

HILLS STREBL ET AL.

Examiner

Dmitry Suhol

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-9 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-9 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

**Priority under 35 U.S.C. §§ 119 and 120**

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892) 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948) 5) ☐ Notice of Informal Patent Application (PTO-152)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_ 6) ☐ Other:

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 1-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Regarding claims 1, 3, 5 and 8, the structural features encompassed by the phrase "means for providing an audio program" can't be determined. It is unclear as to what the applicant intends to encompass as the means for providing an audio program (i.e. is the means an individual who purchases the audio program or is it the housing that holds the program or is it the variety of audio media?). Furthermore the audio program is not positively claimed but only a means for providing such a program is claimed.

Regarding claim 2, the phrase "wherein said object includes a plurality of objects" is unclear. An object implies only one object, therefore it is unclear if the applicant intends to claim at least one object or an object made up of multiple pieces. Examiner suggests changing "an object" to read "at least one object". Furthermore, the features encompassed by the phrase "includes means adapted to include an audible reference to said object..." can't be determined. The structure and function which the applicant is attempting to claim is not clear.

Regarding claims 1-4, an object is not positively claimed. Applicant is claiming a means for supporting an object(s) but not the object itself. It is unclear if applicant intends to claim "an object".

Regarding claim 4, the structural features encompassed by the phrase starting with "...includes presenting said first of said plurality of display objects within the immediate field of view..." and ending with "...display objects away from said immediate field of view of said infant..." can't be determined. It appears as if the claim is drawn to a method of use rather than structural features.

Regarding claim 6, the features encompassed by "means adapted for changing any of said plurality of display objects with a replacement display object" are not clear. It is not understood what structural features applicant is claiming (i.e. a connection between an object and a mobile arm, or an container housing additional objects or something else?).

Regarding claim 7, the features encompassed by "means adapted for replacing any of said means for providing an audio program" are not clear. It is not understood what structural features applicant is claiming (i.e. an ejection button on a tape player or a human hand that changes a CD or a tape or something else?).

In view of the examples above, the applicant is required to carefully review all of the claims in order to correct those having the same or similar defects but not specifically pointed to.

The remainder of the actions considers the claims as best understood.

***Claim Rejections - 35 USC § 102***

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 1-8 are rejected under 35 U.S.C. 102(b) as being anticipated by Fearon et al '360. Fearon discloses an infant mobile containing all the elements of the claims including, a means for supporting an object (figure 1) as required by claims 1 and 3, a means for presenting an object to an infant (motor 30) as required by claims 1 and 3-5, a means for providing an audio program (col. 2, lines 36-41) as required by claims 1 and 3, a plurality of objects (fig. 1, elements 50) as required by claim 2, a means adapted to include an audible reference (col. 2, lines 36-41) as required by claim 2, a means adapted for changing a plurality of objects (fig. 1, elements 55) as required by claim 6. A means for replacing any means for providing an audio program with a replacement audio program is considered to be inherent in that any tape player or CD player would have an eject button to remove and replace a CD/tape.

Since the reference includes all of the structural elements of the claims it is presumed to be inherently capable of all of the claimed functions. Furthermore it should be noted that regarding the terminology "adapted to", it has been held that the recitation

that an element is "adapted to" perform a function is not a positive limitation but only required the ability to so perform. It does not constitute a limitation in any patentable sense. *In re Hutchinson*, 69 USPQ 138.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fearon et al '360 in view of Reynolds et al '098. Fearon discloses a synchronized infant mobile which rotates in response to audible characteristics (col. 3, lines 5-7) containing all the elements of the claims, as stated above, but for an audio program including an audible reference to an object. However, Reynolds teaches a mobile which synchronizes audible sounds with predetermined collectibles/objects (col. 2, lines 30-34). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to incorporate the teachings of Reynolds in the device of Fearon by incorporating audible reference to an object.

Claims 1-9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Fearon et al '360 in view of Baik. Fearon discloses a synchronized infant mobile which rotates in response to audible characteristics (col. 3, lines 5-7) containing all the

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elements of the claims, as stated above, but for an audio program including an audible reference to an object. However, Baik teaches a mobile which synchronizes audible sounds with predetermined objects (page 3, paragraph [0013]). Therefore it would have been obvious to one having ordinary skill in the art, at the time of the claimed invention to incorporate the teachings of Baik in the device of Fearon by incorporating audible reference to an object.

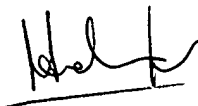
### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dmitry Suhol whose telephone number is 703-305-0085. The examiner can normally be reached on Mon - Friday 9am-5:30pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Derris Banks can be reached on 703-308-1745. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9302 for regular communications and 703-872-9303 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-1148.

ds  
January 2, 2003

  
Jacob K. Ackun  
Primary Examiner